REMARKS

Reconsideration and withdrawal of the rejection and the allowance of all claims now pending in the above-identified patent application (*i.e.*, Claims 20-39) are respectfully requested in view of the foregoing amendments and the following remarks.

At the outset, it should be recognized that the present invention, as now broadly claimed, discloses a method for playing a collateral wagering game in combination with a standard wagering game, which includes the steps of:

making a wager by each player participating in a standard wagering game;

making an additional wager by each player on an outcome of the standard wagering game, the additional wager by each player being optional for participating in a collateral wagering game;

conducting the standard wagering game as a network-linked game played at a plurality of venues for allowing a plurality of players to play the standard wagering game where all players of the plurality of players are not present at a single venue, the plurality of venues not being all included within one casino;

determining whether the outcome of the standard wagering game comprises a winning outcome for each player, wherein a prize amount for the standard wagering game is determined when the winning outcome is achieved in the standard wagering game, each player being capable of having the winning outcome in the standard wagering game and receiving the prize amount for the standard wagering game without having to place the additional wager for participating in the collateral wagering game;

allocating a prize value to the collateral wagering game based upon the winning outcome in the standard wagering game;

determining a collateral game prize value for each player in the collateral wagering game when each player has made said additional wager for participating in the collateral wagering game; and,

paying each player a total prize amount based upon the prize amount as determined in the standard wagering game and the collateral game prize value for the collateral wagering game, as each player is determined to be entitled to receive based upon the outcome of the standard wagering game.

As now recited in the claims, the standard wagering game is intended to be played at a plurality of venues, via a network link, and, preferably, played at the same speed at all venues at which the standard wagering game is conducted. The standard wagering game may, for example, be a lottery game or keno.

As will be explained in greater detail hereinafter, nowhere in the prior art is such a novel method for playing a standard wagering game at a plurality of venues, in combination with an optional collateral wagering game, disclosed or suggested.

Applicant and his Attorney wish to thank the Examiner for withdrawing the final rejection, issued October 16, 2007. The third Office Action, issued January 23, 2008, which has been made "non-final," presents a new anticipation rejection applying Jones *et al.*, U.S. Patent No. 5,377,973 ("Jones *et al.* '973.") The Examiner has specifically applied Jones *et al.* '973 for its contended teaching that "[a] player may win the standard

wagering game, [the] underlying five-card stud poker game, without having to place [an] additional wager for participating in the collateral wagering game." *See*, *Third Office Action* at p. 3.

Applicant had successfully argued against the Examiner's anticipation rejection of the final Office Action, dated October 16, 2007, which applied Suttle *et al.*, U.S. Patent No. 4,836,553, by incorporating a limitation into each of independent Claims 20, 22, 24 and 26 that allowed for a player to win the standard wagering game, yet have the option of declining to make an additional wager to participate in the collateral game, yet still be able to win the standard wagering game; an option which Suttle *et al.* does not permit.

As a matter of record, Jones *et al.* '973 recites an actual filing date of March 14, 1994, which is subsequent to Applicant's Australian priority claim of August 27, 1993, thus rendering Jones *et al.* '973 not directly citable against the present Applicant. Applicant's Attorney has carefully reviewed the prior patents cross-referenced by Jones *et al.* '973, namely, U.S. Patent Nos. 4,861,041 ("Jones *et al.* '041") and 5,078,405 ("Jones *et al.* '405"), which both antedate Applicant's effective filing date and would appear to have identical disclosures, and finds that the feature for which Jones *et al.* '973 has been applied by the Examiner in the third Office Action is, in fact, disclosed in the paragraph bridging Cols. 1 – 2 of each of Jones *et al.* '041 and Jones *et al.* '405.

Consequently, Applicant has further amended his claims to address the Examiner's anticipation rejection of the third Office Action, as if the latest 35 U.S.C. §102(b) anticipation rejection had applied either Jones *et al.* '041 or Jones *et al.* '405.

Accordingly, Applicant has now amended independent Claims 20, 22 and 24 (a similar limitation has been entered for independent Claim 26, which non-substantively differs only for the purpose of providing language consistent with the remainder of this claim) to recite the further method step of:

> "conducting the standard wagering game as a network-linked game played at a plurality of venues for allowing a plurality of players to play the standard wagering game where all players of said plurality of players are not present at a single venue, said plurality of venues not being all included within one casino."

Subject matter support for the foregoing claim limitation exists in Applicant's *Specification*, as filed, at Page 16, lines 9 – 20; Page 27, lines 17 – 19; and FIG. 2, which discusses and schematically illustrates a plurality of participating linked casinos.

Independent Claims 20, 22, 24 and 26 should now be understood as being limited to a method for playing a standard wagering game, in combination with a collateral wagering game, which does not take place solely within one gaming establishment, such as a casino. The claims are written such that there is no requirement that any gaming venue must be a "casino," only that the present invention, as now claimed, excludes a method for playing a standard wagering game, and related collateral game, within the confines of a single casino, a gaming establishing or building housing such gaming. (Applicant has also amended the last two sub-paragraphs of independent Claim 20 to recite that the "total" prize is the prize awarded to a player based upon the combined winnings in both the standard wagering game and the collateral wagering game. This amendment of Claim 20 is intended solely for the purpose of clarity; no substantive amendment of Claim 20 is intended by the amendments entered to the last two sub-

paragraphs of Claim 20 or the conforming amendment entered for dependent Claim 21.)

It is respectfully contended that neither Jones '041 *et al.*, Jones *et al.* '405 nor the collective prior art of record discloses playing a standard wagering game, in combination with a collateral wagering game, at a plurality of venues.

New Claims 28, 31, 34 and 37, which depend from independent Claims 20, 22, 24 and 26, respectively, recite the preferred embodiment that the standard wagering game is played at all venues at the same speed, or "an equal speed." This limitation finds support in Applicant's *Specification* at Page 16, lines 12 – 14, which recites that the standard wagering games operate "at the same speed for all participating casinos," which is neither disclosed nor suggested by the prior art.

Finally, new dependent Claims 29, 32, 35 and 38 recite that the standard wagering game is a "lottery game" which finds support in Applicant's *Specification* at Page 30, line 7 – Page 31, line 12, while new dependent Claims 30, 33, 36 and 39 recite that the standard wagering game is keno.

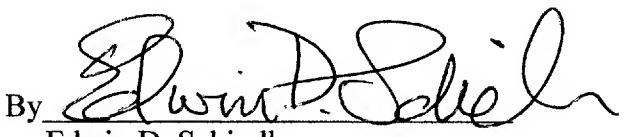
Accordingly, Applicant respectfully submits that the Examiner's 35 U.S.C. §102(b) anticipation rejection of the third Office Action has been overcome and should appropriately be withdrawn.

In light of the foregoing, it is respectfully contended that all claims now pending in the above-identified patent application (*i.e.*, Claims 20-39) recite a novel method for playing a gambling game, which is patentably distinguishable over the prior art. Accord-

ingly, withdrawal of the outstanding rejections and the allowance of all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

CHRISTOPHER R. BYRNE

By 
Edwin D. Schindler
Attorney for Applicant
Reg. No. 31,459

PTO Customer No. 60333

Five Hirsch Avenue
P. O. Box 966
Coram, New York 11727-0966

(631)474-5373

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The Commissioner for Patents is hereby authorized to charge the Deposit Account of Applicant's Attorney (*Account No. 19-0450*) for any fees or costs pertaining to the prosecution of the above-identified patent application, but which have not otherwise been provided for.